

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 53 to 68, Claims 34 to 52 are pending in the present application. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that the claims are now in condition for allowance. Applicants point out that the amendments made herein are made without prejudice to the future prosecution of such cancelled, amended, or modified subject matter in a related divisional, continuation, or continuation-in-part application.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

### **II. Objections to the Drawings**

The drawings were objected under 37 C.F.R. §§ 1.84(p)(4) and 1.84(p)(5). It is respectfully submitted that these objections should be withdrawn for at least the following reasons.

As regards the objection under 37 C.F.R. § 1.84(p)(4), Figures 4 and 5 have been amended herein without prejudice to replace reference characters "40" and "41" with reference characters --41a-- and --41b--, respectively. The Substitute Specification has been amended to accord with the amended figures.

As regards the objection under 37 C.F.R. § 1.84(p)(5), the Substitute Specification has been amended herein without prejudice to include reference character --42--.

In view of the foregoing, withdrawal of these objections is respectfully requested.

### **III. Rejection of Claims 34 to 39, 41 to 50, 53 to 62, and 66 to 68 Under 35 U.S.C. § 102(b)**

Claims 34 to 39, 41 to 50, 53 to 62, and 66 to 68 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,718,682 ("Tucker"). It is respectfully submitted that Tucker does not anticipate these claims for at least the following reasons.

As an initial matter, claims 53 to 62 and 66 to 68 have been canceled herein without prejudice, thereby rendering moot the present rejection with regard to claims 53 to 62 and 66 to 68.

Claim 34 recites that a port for a catheter includes a chamber for receiving active substances, the chamber being arranged in a housing and closed off by a piercable membrane, and a connecting piece, the connecting piece being capable of connecting to the catheter and in fluid connection with the chamber. Claim 34 also recites that the port includes clamping jaws, the clamping jaws **connected to the housing** and having clamping faces that are situated opposite one another, the clamping jaws being **movable from a first position, in which the clamping jaws are spaced away from the housing laterally, to a second position in which the clamping jaws fix the catheter in place between their clamping faces by a clamping action.**

Tucker discloses, referring to Figure 4, an implantable access port device comprising a housing 42, a septum 44, and a cup unit 46. The septum 44 and the cup unit 46 are inserted into the housing 42. The cup unit 46 comprises a cup-shaped element 54 and cup ring halves 56a and 56b. These components are mechanically compressed together while the bottom of the cup element is subjected to vibration at ultrasonic frequencies, thereby **melting and permanently welding** the components together. See col. 4, lines 29 to 40. As these components are permanently fixed together, it is plainly apparent that they are not movable with respect to one another. This is in contrast to the device of claim 1 of the present application, which recites clamping jaws that are **connected to the housing and movable between a first position and a second position.** The Office Action relies on Figure 6 as showing the halves 56a and 56b in a first position; however, Figure 6 shows the halves 56a and 56b in an exploded view prior to assembly. In this position, it is plainly apparent that neither of the two cup ring halves 56a and 56b is connected to any other portion of the device. Indeed, Tucker does not disclose, or even suggest, clamping jaws that are connected to the housing and movable between a first position and a second position.

Further, Tucker does not disclose, or even suggest, clamping jaws having **a second position in which the clamping jaws fix the catheter in place between their clamping faces by a clamping action.** In this regard, the Office

Action asserts at page 3 that the cup ring halves 56a and 56b "move[] to a second position (figure 5) where clamps 56 are capable of fixing a catheter between the clamping faces 64 depending on how the catheter is arranged along tube 60." As an initial matter, this assertion is apparently based entirely on speculation and conjecture, which cannot support an anticipation (or obviousness) rejection. Moreover, the figures of Tucker do not support the Office Action's position. As is clear from Figures 4 to 6, portion 64 of the cup ring halves 56a and 56b closely fits around the outlet tube 60. Thus, it is plainly apparent that the device is not arranged to be assembled with a catheter inserted over the outlet tube and between the cup ring halves 56a and 56b. Further it would not be obvious for one of ordinary skill in the art to attach a catheter in the manner suggested by the Office Action, as this would cause the rings to fit improperly, thereby preventing the device from being properly assembled.

Of course, it is "well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As indicated above, Tucker does not disclose, or even suggest, all of the features recited in claim 34. As such, it is respectfully submitted that Tucker does not anticipate claim 34 or any of claims 35 to 39 and 41 to 50, which ultimately depend from claim 34.

In view of all of the foregoing, withdrawal of the present rejection is respectfully requested.

**IV. Rejection of Claim 40 Under 35 U.S.C. § 103(a)**

Claim 40 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Tucker and U.S. Patent No. 6,165,157 ("Dillon et al."). It is respectfully submitted that the combination of Tucker and Dillon et al. does not render claim 40 unpatentable for at least the following reasons.

Claim 40 depends from claim 34 and therefore includes all of the features recited in claim 34. As more fully set forth above, Tucker does not disclose or suggest all of the features of claim 34. Dillon et al. is not relied upon for disclosing the features of claim 34 not disclosed or suggested by Tucker. Indeed, Dillon et al. does not disclose, or even suggest, the features of claim 34 not disclosed or suggested by Tucker.

In view of the foregoing, it is respectfully submitted that the combination of Tucker and Dillon et al. does not disclose or suggest all of the features of claim 40. As such, it is respectfully submitted that the combination of Tucker and Dillon et al. does not render unpatentable claim 40. Accordingly, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 51, 52, and 63 to 65 Under 35 U.S.C. § 103(a)**

Claims 51, 52, and 63 to 65 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Tucker and U.S. Patent No. 5,167,638 ("Felix et al."). It is respectfully submitted that the combination of Tucker and Felix et al. does not render unpatentable these claims for at least the following reasons.

As an initial matter, while the Office Action indicates that claims 60 to 62 have been rejected under 35 U.S.C. § 103(a), as best understood by Applicants, the Office Action intended to indicate claims 63 to 65, rather than claims 60 to 62, as the present rejection appears directed to the subject matter of claims 63 to 65.

As another initial matter, claims 63 to 65 have been canceled herein without prejudice, thereby rendering moot the present rejection with regard to claims 63 to 65.

Claims 51 and 52 ultimately depend from claim 34 and therefore include all of the features recited in claim 34. As more fully set forth above, Tucker does not disclose or suggest all of the features of claim 34. Felix et al. is not relied upon for disclosing the features of Tucker not disclosed or suggested by Tucker.

Indeed, Felix et al. does not disclose, or even suggest, the features of claim 34 not disclosed or suggested by Tucker.

In view of the foregoing, it is respectfully submitted that the combination of Tucker and Felix et al. does not disclose or suggest all of the features of either of claims 51 and 52. As such, it is respectfully submitted that the combination of Tucker and Felix et al. does not render unpatentable either of claims 51 and 52. Accordingly, withdrawal of these rejections is respectfully requested.

**VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Attachments

**APPENDIX**